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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,545	09/29/2000	Neil Katz	6169-140	2722

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EXAMINER	
BUI, KIEU OANH T	

ART UNIT	PAPER NUMBER
2611	9

DATE MAILED: 07/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/676,545	KATZ ET AL.	
	Examiner	Art Unit	
	KIEU-OANH T BUI	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 May 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Remarks

1. Claims 10-16 and 19-20 were withdrawn, and claims 21-27 were canceled in the amendment paper no. 7 (dated 05/07/04). Pending claims are now claims 1-9 and 17-18.

Response to Arguments

2. Applicant's arguments with respect to claims 1-9 and 17-18 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> *(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.*
> *The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).*

4. Claims 1 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Krapf (US Patent No. 6,483,986 B1).

Regarding claim 1, Krapf discloses "a method for providing configurable access to media in a media-on-demand system comprising the steps of: delivering the media to a first client device through a first communications link wherein said first client device is associated with a first user; recording a bookmark specifying a position in the media; and delivering the media to a

second client device through a second communications link, said delivery to said second client device beginning at said position specified by said recorded bookmark wherein said second client device also is associated with said first user", i.e., as illustrated in Figure 4, a first user of system 1 associated with a first client device 24 (a set top box) can access to video-on-demand system or headend 26 by using a remote controller 6 via communication link 28 or cable link, wherein the viewing device 4 is a television, and the user can pause a viewing program by using bookmarking feature, and the second client device 2 (a personal video recorder) via a second communication link (modem) later helps the user to resume at the point where the user hasn't finished viewing the program or the first content 12, wherein the second client device is associated with the same first user (see col. 5/line 31 to col. 6/line 37, also please note that the bookmarking occurs even the user does not set up the recording).

Regarding claim 17, Krapf discloses "a method for providing configurable access to media in a media-on-demand system comprising: delivering the media to a first client device in a format compatible with said first client device, wherein said first client device is associated with a first user; interrupting said delivery of said media; recording a bookmark specifying a position in the media when said interruption occurred; and resuming delivery of the media to a second client device, said resumed delivery beginning at a position in the media specified by said recorded bookmark, wherein said second client device also is associated with said first user"; i.e., ., as illustrated in Figure 4, a first user of system 1 associated with a first client device 24 (a set top box) can access to video-on-demand system or headend 26 by using a remote controller 6 via communication link 28 or cable link, wherein the viewing device 4 is a television, and the user can pause a viewing program by using bookmarking feature, and the second client device 2

(a personal video recorder) via a second communication link (modem) later helps the user to resume at the point where the user hasn't finished viewing the program or the first content 12, wherein the second client device is associated with the same first user (see col. 5/line 31 to col. 6/line 37, also please note that the bookmarking occurs even the user does not set up the recording).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

6. Claims 2-9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kraft (US Patent 6,483,986 B1) in view of Hooper et al. (U.S. Patent No. 5,442,390).

As for claims 2 and 18, in view of claim 1 above, Krapf does not disclose the steps of identifying the devices; however, in a same environment of providing on-demand services to users, Hooper further discloses "further comprising the steps of identifying device properties for each of said first and second client devices; and, delivering the media to said first and second client devices through said respectively established first and second communications links, the media delivered in a format compatible with said identified device properties", i.e., a configuration process including customer's information and the configuration of their device is performed for identifying a particular viewer and their associated device at their location on how

to communicate to them (Hooper, Fig. 4/step 420, and col. 8/lines 4-22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Krapf's technique with well-known identifying technique as taught by Hooper in order to ensure the service to deliver to subscribed customers to avoid fraudulent activities.

As for claim 3, in further view of claim 2 above, both Krapf and Hooper further discloses "wherein the media is stored in a media-on-demand server (MODS) and delivered to said first and said second client devices via said first and said second communications link respectively", i.e., broadcast headend of Kraft regarding as a media on-demand server for delivering video-on-demand (Krapf, col. 6/lines 16-23), and media is stored on media-on-demand server or VOS system 20 and delivered to the CPE 10 at different locations via corresponding links (Hooper, Fig. 1 with arrows for links, i.e.,, twisted pair of wires, coaxial cables, fiber optic cables, micro-wave or satellite links, col. 3/lines 1-25).

As for claim 4, in further view of claim 3 above, Hooper further discloses "wherein said step of delivering the media to said first client device via said first communications link, comprises receiving the media from said MODS in an intermediate server; in said intermediate server, converting the media to a format compatible with said identified device properties of said first client device; and delivering said converted media to said first client device via said first communications link", i.e., the media is delivered via a first communications link to a first client device via an intermediate server as an interface box converter 11, this server converts the receiving media to a compatible format to the client device, for instance, HDTV to a television (Fig. 12, and col. 14/lines 4-54).

As for claim 5, in further view of claim 3 above, Hooper discloses "wherein said step of delivering the media to a second client device via said second communications link, comprises: receiving the media in an intermediate server from said MODS; in said intermediate server, converting the media to a format compatible with said identified device properties of said second client device; and delivering said converted media to said second client device via said second communications link", i.e., the media is delivered via a second communications link to a second client device via an intermediate server as an interface box converter 11, this server converts the receiving media to a compatible format to the client device, for instance, signals to a monitor of a personal computer PC (Fig. 12, and col. 14/lines 4-54).

As for claim 6, in further view of claim 3 above, Hooper discloses further "comprising: storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said plurality of media-on-demand servers storing the media in at least one format compatible with a selected device type; selecting a MODS for delivering the media to said first client device, said selected MODS having stored thereon the media in a format compatible with said first client device; and delivering from said selected MODS the media in a format compatible with said first client device", i.e., a library server 23 with a juke box 41 serves as a stored media for clients in selecting programs and each server stores media with compatible formats to the client device with different ports to different networks (Fig. 2, and col. 4/lines 18-53).

As for claim 7, in further view of claim 6 above, Hooper further discloses "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said first client device in a format compatible with said first client device; if it is determined that a MODS is not available for delivering the media to said first client device in a format

compatible with said first client device, selecting a MODS for delivering the media to said first client device, said selected MODS containing the media in a standard format, and converting the media in said standard format to a format compatible with said first client device", i.e., a configuration process is performed for providing appropriate type of broadcasting program if available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being converted at the interface converter as in claim 5 above.

As for claims 8 and 9, in further view of claim 3 above, Hooper further discloses "further comprising: storing the media in selected ones of a plurality of media-on-demand servers, each MODS in said plurality of media-on-demand servers storing the media in at least one format compatible with a selected device type; selecting a MODS for delivering the media to said second client device, said selected MODS having stored thereon the media in a format compatible with said second client device; and delivering from said selected MODS the media in a format compatible with said second client device" and "wherein said selecting step further comprises: determining if a MODS is available for delivering the media to said second client device in a format compatible with said second client device; if it is determined that a MODS is not available for delivering the media to said second client device in a format compatible with said second client device, selecting a MODS for delivering the media to said second client device, said selected MODS containing the media in a standard format, and converting the media in said standard format to a format compatible with said second client device", i.e., a configuration process is performed for providing appropriate type of broadcasting program if available, if not, an alternative choice such as creating a broadcast stream (col. 7/lines 25-37), as

a standard format, to the client device (col. 8/lines 13-53), and then the broadcast stream is being converted at the interface converter as in claims 4-5 above, whether a second device is a HDTV television or a PC.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lamkin et al (US Pub 2002/0088011 A1) and Dan et al (US Patent 5,453,779) disclose systems related to bookmarking of video programs.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9306, (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (703) 305-0095. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant, can be reached on (703) 305-4755.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Krista Bui
Art Unit 2611
July 15, 2004

KRISTA BUI
PATENT EXAMINER